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**MAY 21 2003**

**OFFICE OF PETITIONS**

In re Application of :  
John R. Bianchi et al. :  
Application No. 09/782,594 :  
Filed: February 12, 2001 :  
Title of Invention: ASSEMBLED :  
IMPLANT :

: DECISION GRANTING DECISION  
: UNDER 37 CFR 1.78(a)(3)

This is a decision on the Response to Decision Dismissing Petition under 37 CFR 1.78(a)(3), filed September 3, 2002, and supplemented via facsimile on March 28, 2003, and May 12, 2003, to accept an unintentionally delayed claim under 35 USC 120 for the benefit of prior filed copending nonprovisional applications, numbers 08/920,630, filed August 27, 1997; 09/191,232, filed November 13, 1998, now U.S. patent 6,482,584; 09/378,527, filed August 20, 1999; 09/722,205, filed November 25, 2000; 09/390,174, filed September 7, 1999; and 29/123,227, filed May 12, 2000. A petition for a five (5) month extension of time is also requested and is hereby granted.

The petition is **GRANTED**.

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR 1.78(a)(2)(ii). In addition, the petition under 37 CFR 1.78(a)(3) must be accompanied by:

(1) the reference required by 35 U.S.C. § 120 and 37 CFR 1.78(a)(2)(i) of the prior-filed application, unless previously submitted;<sup>1</sup>

<sup>1</sup> Any nonprovisional application or international application designating the United States of America claiming the benefit of one or more prior-filed copending applications or international applications designating the United States of America must contain or be amended to contain a reference (amendment to the first line of the specification following the title or in an application data sheet (ADS) to each such prior-

- (2) the surcharge set forth in § 1.17(t); and
- (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and the date the claim was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional.

#### Background

A petition to accept an unintentionally delayed claim for the benefit of two prior filed copending applications, filed July 25, 2001, was dismissed by this Office in a Decision mailed on September 5, 2001, because a reference to the subject two prior nonprovisional applications had not been included in an ADS as provided by 37 CFR 1.76 or in the first sentence of the specification following the title as required by 37 CFR 1.78(a)(2). Also, the statement in the first line of the specification which stated that "[t]his application is a continuation-in-part of pending provisional application serial number 60/181,622" was improper.

Petitioner responded with a petition filed on January 7, 2002. That petition was dismissed by this Office in a decision mailed on May 10, 2002 because it lacked item (1) *infra*. Petitioner had not indicated the relationship of the applications for which the benefit was sought and the instant application as required by 37 CFR 1.78(a)(2).

Petitioner was required to amend the specification to state the relationship of the instant application to the application(s) for which the benefit was sought. Petitioner was further advised that the proposed amendment had lumped together, and thus confused, claims for the benefit under both 35 USC 119(e) and 35 USC 120. As was noted above, it is inappropriate for applicant to denote a given application as continuation of a continuation-in-part of a provisional application. The proposed amendment was also improper for another reason: where it attempted to incorporate by

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filed application, identifying it by application number (consisting of the series code and serial number) or international application number and international filing date filing date and indicating the relationship of the applications. Cross references to other related applications may be made when appropriate (see § 1.14).

reference, after the filing date, one or more previous applications. The proposed amendment under 35 USC 120 could not be accepted as drafted since it improperly incorporated by reference the prior applications.

#### The Instant Petition

The instant pending application was filed on February 12, 2001, and was pending at the time of filing of the instant petition. A reference to the prior-filed nonprovisional application has been included in an amendment to the first sentence of the specification following the title, as required by 37 CFR 1.78(a)(2)(iii).

Also, the instant nonprovisional application was filed after November 29, 2000, and the claim herein for the benefit of priority to the prior-filed application is submitted after expiration of the period specified in 37 CFR 1.78(a)(2)(ii). Further to this, the reference to the prior-filed application was submitted during the pendency of the instant nonprovisional application, for which the claim for benefit of priority is sought. See 35 U.S.C. § 120. Accordingly, having found that the instant petition for acceptance of an unintentionally delayed claim for the benefit of priority under 35 U.S.C. § 120 to the prior-filed application satisfies the conditions of 37 CFR 1.78(a)(3), the petition is granted.

The granting of the petition to accept the delayed benefit claim to the prior-filed application under 37 CFR 1.78(a)(3) should not be construed as meaning that the instant application is entitled to the benefit of the prior-filed application. In order for the instant application to be entitled to the benefit of the prior-filed application, all other requirements under 35 U.S.C. § 120 and 37 CFR 1.78(a)(1) and (a)(2) must be met. Similarly, the fact that the corrected Filing Receipt accompanying this decision on petition includes the prior-filed application should not be construed as meaning that applicant is entitled to the claim for benefit of priority to the prior-filed application noted thereon. Accordingly, the examiner will, in due course, consider this benefit claim and determine whether the instant application is entitled to the benefit of the earlier filing date.

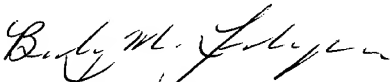
A corrected Filing Receipt, which includes the priority claim to the prior-filed nonprovisional application, accompanies this decision on petition.

This application is being forwarded to Technology Center Art Unit

2831 for consideration by the examiner of applicant's entitlement to claim benefit of priority under 35 U.S.C. § 120 to prior-filed nonprovisional Application Nos. numbers 08/920,630, filed August 27, 1997; 09/191,232, filed November 13, 1998, now U.S. patent 6,482,584; 09/378,527, filed August 20, 1999; 09/722,205, filed November 25, 2000; 09/390,174, filed September 7, 1999; and design application No. 29/123,227, filed May 12, 2000.

**ATTACHMENT:** Corrected Filing Receipt

Telephone inquiries concerning this matter should be directed to petitions attorney Derek L. Woods at (703) 305-0014.

  
Beverly M. Eganagan  
Supervisory Petitions Examiner  
Office of Petitions